sending specific consumer information relating to either purchases, coupons or both to a data center.

Claim 23. (Amended) The system as in claim 3 or 4, further comprising means for sorting the unutilized coupon information.

Claim 24. (Amended) The system as in claim 10 or 11, further comprising means for sorting the unutilized coupon information.

Claim 29. (Amended) The system of claim 1, further comprising means for electronically sending coupons from a manufacturer to the specific consumer by adding unutilized manufacturer coupon information to the coupon data base.

Remarks and Request for Reconsideration

Claims 1-29 remain in the case. Claims 1-2, 4-9, 11-14, 18-19, 21-24 and 29 have been amended to more clearly define the invention as having the data base store *unutilized* coupon information for *more than one* consumer. The scanning claims (7, 13, 19, and 22) have been amended to further define clipped coupons as the source of the unutilized coupon information.

Support for these amendments can be found in the application as originally filed. More particularly, coupon utilization is discussed at page 4, line 8; page 11, lines 4 and 20; page 14, line 7; and page 15, line 4. Coupon utilization inherently discloses that the coupons were "unutilized" at a time prior to utilization.

Support for the data base containing information for a plurality of consumers can be found throughout the specification, particularly at page 5, lines 1-5 and page 12, lines 8-10 and 13-17.

Support for clipped coupons can be found at page 5, line 9 and page 12, line 9, with scanning of them at page 5, lines 9-10. No new matter has been added by this amendment.

During the interview of January 24, Applicant proposed adding the term "paperlessly" to the reconciling elements of the claims, but has not done so since the claim language requires reconciling *unutilized coupon information from or in the coupon database* with the purchase information, which is *explicitly paperless*.

Also during the interview, "unredeemed" was proposed as a modifier for coupon information, but it was suggested that this language may be confused with used coupons which have not been redeemed via a clearinghouse. To avoid this, the term --unutilized-- has been used.

Claim Rejections - 35 USC §102

Claims 1-29 were rejected under 35 USC §102(e) as being anticipated by <u>Fajkowski</u> (U.S. Patent No. 5,905,246).

The system of <u>Fajkowski</u> uses a coupon card 1 for storing unutilized coupon information of a single consumer in RAM, to be read by a card reading periphery device 100 at checkout. The card 1 has its own bar code scanner for inputting coupon information into RAM. <u>Fajkowski</u> also discloses a kiosk with a coupon dispenser 250 for adding electronic coupons to cards 1. As stated in the abstract, <u>Fajkowski</u> is drawn to:

> "a system for the electronic management and redemption of coupons. The system includes an *integrated coupon card* comprising a microprocessor, a random access memory, a scanner, and a communications port. The *coupon card* is capable of scanning coupon bar codes from paper coupons and receiving redemption requirement data from a periphery device. The *coupon card* will allow bar codes and redemption requirement data to be transferred to a periphery device and will store what bar codes were redeemed because they corresponded to purchase data received from a cash register memory. The system *further includes one or more periphery devices having a microprocessor, a first communications port for communicating with said coupon card, and a second communications*

port for communicating with a cash register. The periphery devices receive purchase data from a cash register memory and compare purchase data to coupon bar codes received from a *coupon card* in order to determine which coupons are redeemable. The system also includes a server computer which will be connected to the periphery devices. The *server computer will collect redeemed coupon information from the periphery devices* and also provide the periphery devices with information such redemption requirement data or coupons which may be loaded onto a coupon card. A clearing house will collect coupon redemption information from all servers in the system to create redemption reports. The clearing house allows redemption requirement data and other information to be transferred through the servers to individual periphery devices and/or *coupon cards*." (Emphasis added)

To anticipate a claim, the reference must teach every element of the claim:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See MPEP Section 2131.01.

In the present case, independent claims 1, 8, 14, 21, and 22 are drawn to systems and

methods which include the limitation of a data base containing **unutilized** coupon information

attributed to each of **a plurality of consumers**, as shown below:

Claim 1.   An electronic coupon processing system comprising:
a coupon data base containing **unutilized** coupon information associated to **each of a plurality of consumers**;
a system for recording specific consumer purchase information at a store;
a system for reconciling the unutilized coupon information in the coupon data base with the specific consumer purchase information; and
means for updating the coupon data base to reflect utilization of coupons.

Claim 8.   An electronic coupon processing system comprising:
a coupon data base containing **unutilized** coupon information associated to **each of a plurality of consumers**;
means for entering the unutilized coupon information into the coupon data base and **associating it with a specific consumer**;
a check-out register capable of recording specific consumer purchase information;
a system for reconciling the unutilized coupon information in the coupon data base with the specific consumer purchase information; and
means for updating the coupon data base to reflect utilization of coupons.

Claim 14.   A method for electronic coupon processing comprising:
entering **unutilized** coupon information of **a plurality of consumers** into a coupon data base, where the **unutilized coupon information is attributed to a specific consumer**;
reading consumer purchase information at a store;
reconciling the unutilized coupon information from the coupon data base with the consumer purchase information;
deducting any discount or rebate from the consumer charges based on the reconciliation; and updating the coupon data base to reflect the reconciliation.

Claim 21.   A method for electronic processing of discount coupons comprising:
entering **unutilized** coupon information of **a plurality of consumers** into a coupon data base, where the **unutilized coupon information is attributed and accessible to a specific consumer**;
reading specific consumer purchase information at a store;
reconciling the unutilized coupon information from the coupon data base with the specific consumer purchase information;
deducting any discount or rebate from the consumer charges based on the reconciliation; and updating the coupon data base to reflect the reconciliation.

Claim 22.   A method for electronic processing of discount coupons comprising:
reading coupon information of **a plurality of consumers** from **unutilized** clipped coupons with a bar code scanner and sending the unutilized coupon information to a data base where the **unutilized coupon information is attributed to a specific consumer**;
scanning information of products chosen by a specific consumer at a check out register having the capability to identify the specific consumer in relation to the coupon data base;
reconciling the unutilized coupon information with the register information and providing any applicable discount to the specific consumer at the register;
updating the data base to reflect purchases and discounts given at the register;
sending the utilized coupon information and register information to a source for reimbursement to vendor; and
sending specific consumer information relating to either purchases, coupons or both to a data center.

Fajkowski discloses only a coupon card 1 with a "data base" for holding the unutilized coupon information of a single consumer, the cardholder, and **does not disclose a data base holding coupon information of a plurality of consumers**. The kiosk coupon dispenser 250 of Fajkowski holds unutilized coupon information, **but does not associate the information on a data base with a specific consumer**. Server 200 of Fajkowski discloses holding redeemed (or utilized) coupon information of a plurality of consumers for clearinghouse and data mining purposes, but **does not disclose a data base holding unutilized coupon information of a plurality of consumers**.

Because Fajkowski fails to disclose Applicant's claimed data base for the reasons cited above, independent claims 1, 8, 14, 21, and 22, and claims 2-7, 9-13, 15-20, and 23-29 that depend therefrom, are not anticipated by Fajkowski.

With respect to claims 2, 9, and 15 concerning consumer access to their unutilized coupon information to review, the Examiner cited column 4, lines 15-33 discussing display by the periphery device 100 of a list of redeemable coupons. However, the list of redeemable coupons is only *part* of the consumer's coupon information on the data base, so the disclosure cited by the Examiner fails to fully meet the claim limitations. Fajkowski additionally discloses access and review of the "shopping list" portion of a consumer's coupon data base at dispenser 250, which again is only a *portion* of the data base, so this disclosure also fails to fully meet the claim limitations.

With respect to claims 3, 10, and 16 concerning consumer access to their unutilized coupon information via the Internet, the Examiner cited column 6, lines 20-43 discussing loading of coupons from the Internet onto coupon card 1 via an adapter and the disk drive of a computer. No mention of access or review by the consumer of unutilized coupon information in the "data base" is disclosed in the cited portion of Fajkowski, and since the "data base" is on the coupon card 1, no Internet access would ever be necessary.

With respect to claims 4, 11, and 17 concerning consumer access to their unutilized coupon information at the store, the Examiner again cited column 4, lines 15-33 discussing display by the periphery device 100 of a list of redeemable coupons. However, as noted above, the list of redeemable coupons is only *part* of the consumer's coupon information on the data base, so the disclosure cited by the Examiner fails to fully meet the claim limitations. Fajkowski

additionally discloses access and review of the "shopping list" portion of a consumer's coupon data base at dispenser 250, which again is only a *portion* of the data base, so this disclosure also fails to fully meet the claim limitations.

With respect to claims 5, 12, and 18 concerning consumer access to their unutilized coupon information via a printout, the Examiner cited column 27, lines 36-67 discussing printing of a "shopping list" of redeemable coupons. However, the shopping list of redeemable coupons is only *part* of the consumer's coupon information on the data base, so the disclosure cited by the Examiner fails to fully meet the claim limitations.

With respect to claims 20 and 25-27 concerning the data base being shared by more than one store or a centralized database for a plurality of stores, the Examiner cited column 23, lines 20-36 discussing servers 200 connected to clearinghouse 300 for redeemed coupon data, column 26, lines 51-60 discussing dispenser 250 and column 28, line 51 thru column 29, line 4 discussing dispenser 250 connected to remote database 500 for supplying advertising data and coupon data. However, servers 200 and clearinghouse 300 are for redeemed (or utilized) coupon data, **not for a data base holding <u>unutilized</u> coupon information of a plurality of consumers where the unutilized coupon information is attributed to or associated with a specific consumer**. Dispenser 250 and remote database 500 hold unutilized coupon information, but **not unutilized coupon information that is attributed to or associated with a specific consumer**. For these reasons, the disclosures in <u>Fajkowski</u> cited by the Examiner fail to fully meet the claim limitations.

With respect to claim 29 concerning means for electronically sending coupons from a manufacturer to the specific consumer by adding unutilized manufacturer coupon information to

the coupon data base, the Examiner cited column 5, line 39 thru column 6, line 43 discussing

manufacturers sending information to the periphery device for changing coupon values and

giving rebates; manufacturers sending information to the kiosk coupon dispenser; and Internet

delivery to a computer with an adapter to load information to the card. The Examiner also cites

column 14, line 55 thru column 15, line 10 discussing scanning product UPCs with the card 1 to

find corresponding coupons from the manufacturer in the card "data base", which has nothing to

do with the claim limitations (no electronic coupon delivery occurs).

It is Applicant's position that *changing coupon values* and giving *rebates* do not

constitute delivery of coupons, that the disclosed Internet delivery of coupons *fails to mention*

manufacturer delivery, and that the *scanning of UPC codes to aid in locating coupons in the data*

base does not concern electronic delivery of coupons to the data base. For these reasons, the

disclosures in Fajkowski cited by the Examiner fail to fully meet the claim limitations.

Obviousness

In addition to Fajkowski, the Examiner also cited Larson et al., West et al., Jovicic et al.,

Leonard et al., and publications to Fawcett and NetValue Inc.

Fajkowski does not render claims obvious since the coupon card 1 with a unique

consumer access code is CRITICAL to the storage of unutilized coupon information in his

invention and TEACHES AGAINST combination with database for storing coupon information

associated with a plurality of customers. See also the "integrated coupon card" (i.e., integral) of

the abstract.

The system of Leonard et al. is drawn to electronic coupon management for

telecommunication goods and services wherein an operator can check status of the coupon from

a consumer on a telephone line by checking a data base containing unredeemed coupon information associated to a plurality of consumers, redeem it, and update the database.

Leonard et al. does not anticipate because it lacks "a system for recording specific consumer purchase information at a store" or "check out register" element and does not render claims obvious since telephone/operator delivery of goods and services is CRITICAL to their invention and TEACHES AGAINST combination with purchase information from a retail store (see col. 1, "Related Art").

Jovicic et al. discloses an Internet coupon generating and redemption system. Coupons are printed out or stored on e-mail for use by a consumer. Coupon verification and redemption is also done on the Internet.

Jovicic et al. does not anticipate because it lacks "a system for recording specific consumer purchase information at a store" or "check out register" element and does not render claims obvious since it teaches use of paper coupons in the store environment, and paperless only on-line, thereby TEACHING AGAINST paperless store redemption *via a data base*.

West et al. discloses an electronic coupon dispensing system which allows consumers to select coupons and print them out for use.

West et al. does not anticipate since it lacks "a coupon data base containing unutilized coupon information associated to a plurality of consumers" and "a system for reconciling the unutilized coupon information *in the coupon data base* with the specific consumer purchase information". West et al. does not render claims obvious since it is merely a dispenser and teaches against the present invention in that it TEACHES use at the checkout of PAPER coupons, not *via a data base*.
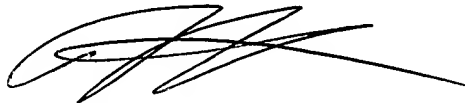
Larson et al. is quite similar to West et al. and fails for the same reasons.

The publications to Fawcett and NetValue Inc. disclose Internet coupon delivery similar to Jovicic et al. and fail to anticipate or render the claims obvious for like reasons.

Conclusion

For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 1-29 and requests reconsideration of the application. If there remain any issues that may be disposed of via a telephonic interview, the Examiner is kindly invited to contact the undersigned at the local exchange given below.

Respectfully submitted,

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CERTIFICATE OF EXPRESS MAILING

Express Mail Mailing Label Number ___EL528294997US_____

Date of Deposit: _____February 3, 2000_____

I hereby certify that the preliminary amendment for patent application of Dale Burns for an **ELECTRONIC COUPON PROCESSING SYSTEM** is being deposited with the United States Postal Service for "Express Mail" service under 37 C.F.R. § 1.10 on the date indicated above and are addressed to the Assistant Commissioner for Patents, Box Non-Fee Amendment, Washington, D.C. 20231.

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